

REMARKS

Entry of the foregoing, reexamination and further and favorable reconsideration of the subject application, in light of the following remarks pursuant to and consistent with 37 C.F.R. § 1.112, are respectfully requested.

By the foregoing amendments, claim 3 has been canceled, without prejudice or disclaimer as to the subject matter disclosed therein, in order to remove the redundancy between claim 1 and claim 3. Because the claims submitted in the above-captioned application were the claims submitted in response to the Written Opinion, claims 1, 2 and 10 have been amended to place the claims into the same form as filed with the PCT application. No new matter has been added by the foregoing amendments.

RESPONSE TO RESTRICTION REQUIREMENT

The Examiner has required that the present application be restricted, under 35 U.S.C. §§ 121 and 372, to one of the following two groups of claims:

Group I: Claims 1-7 and 9-18, drawn to an isolated DNA encoding, expression vectors and host cells for expressing, and a process for using said host cells for the manufacture of a glucoronyl C5-epimerase.

Group II: Claims 8, 19 and 20, drawn to glucoronyl C5-epimerases and functional derivatives thereof.

Applicants hereby elect, **with traverse**, the invention defined by the Examiner as Group I, which includes claims 1-7 and 9-18. For the reasons set forth below, Applicants

request that the restriction requirement be modified so that the inventions of Groups I and II be examined together.

The restriction is traversed. Applicants respectfully note that during review by the International Searching Authority (ISA), the claims of the PCT application did not receive a lack of unity rejection. Because unity of invention was found for the PCT application under PCT Rule 13, Applicants submit that the current restriction requirement is improper.

In Caterpillar Tractor Co. v. Commissioner of Patents and Trademarks, 231 U.S.P.Q. 590, 590-1 (E.D. Va 1986), the Court held that a restriction requirement of claims found to have unity runs afoul of Article 27. Article 27 provides in part:

(1) No national law shall require compliance with requirements relating to the form or contents of the international application different from or additional to those which are provided for in this Treaty and the Regulations.

Thus, analogous to the facts of Caterpillar, as this application was filed under 35 U.S.C. § 371 and the claims were found to have unity by the International Searching Authority, the U.S. Patent and Trademark Office cannot not now require a restriction. Requiring a restriction would run afoul of Article 27. Accordingly, Applicants request that the claims of Group II be rejoined with the claims of Group I. Applicants have attached a copy of the decision in Caterpillar for the convenience of the Examiner.

On a separate note, Applicants respectfully note that the compounds of the claimed invention are glucuronyl C5-epimerases, rather than glucoronyl C5-epimerases.

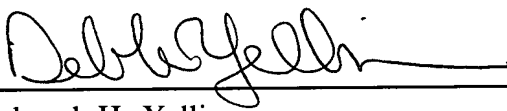
CONCLUSION

Applicants submit that the present application is fully in condition for examination.
An early examination on the merits is earnestly solicited.

In the event that there are any questions relating to this application, it would be appreciated if the Examiner would telephone the undersigned concerning such questions so that prosecution of this application may be expedited.

Respectfully submitted,

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Date: May 17, 2001



Attachment to Amendment and Response to Restriction Requirement

dated May 17, 2001

Marked-up Claims 1, 2 and 10

1. (Amended) An isolated or recombinant DNA sequence coding for a mammalian, including human, glucuronyl C5-epimerase, or a functional derivative thereof [of said DNA sequence], capable of converting D-glucuronic acid (GlcA) to L-iduronic acid (IdoA) constituted by a nucleotide sequence comprising nucleotide residues 1 to 1404, inclusive, as depicted in the sequence listing.

2. (Amended) A DNA sequence according to claim 1 constituted by a nucleotide sequence [residue] comprising nucleotide residues 73 to 1404, inclusive, as depicted in the sequence listing.

10. (Amended) A recombinant expression vector containing a transcription unit comprising a DNA sequence according to claim 1 [3], a transcriptional promoter, and a polyadenylation sequence.

the word portion of applicant's mark. Because of our finding that the words "CONSTRUCT-A-CLOSET" are merely descriptive of applicant's goods, however, applicant is not entitled to registration of its mark as a whole absent a disclaimer of the words "CONSTRUCT-A-CLOSET".

Decision: The refusal of registration is affirmed. Applicant is, however, permitted (30 days from the date of this decision in which to submit a disclaimer of the words "CONSTRUCT-A-CLOSET", whereupon the refusal of registration will be set aside and the mark forwarded for publication, upon entry of such disclaimer. Trademark Rule 2.142(g).

District Court, E.D. Virginia

Caterpillar Tractor Co. v.
Commissioner of Patents and Trademarks

No. 84-1212-A
Decided May 28, 1986

PATENTS

1. Foreign patents (§38.)

Pleading and practice in Patent Office— Rules effect (§34.9)

Patent and Trademark Office rule, 37 CFR 1.141(b)(2), which, in interpreting Patent Cooperation Treaty's unity of invention requirement that permits single international patent application for process and apparatus if apparatus is "specifically designed for carrying out the said process," requires that apparatus "cannot be used to practice another materially different process," violates PCT and thus is contrary to law.

Action by Caterpillar Tractor Co. against Commissioner of Patents and Trademarks. On cross-motions for summary judgment. Plaintiff's motion granted.

See also 226 USPQ 625 and 228 USPQ 77.

R. E. Muir and J. W. Keen, Peoria, Ill.; James C. Wood, Jeffrey L. Clark, and Wood, Dalton, Phillips, Mason & Rowe, Chicago, Ill.; Douglas P. Mueller and Wegner & Breischneider, Arlington, Va., for plaintiff.

Joseph F. Nakamura, solicitor, Fred E. McKelvey, deputy solicitor, and Paula P. Newell for defendant.

Bryan, District Judge.

In this action involving an international patent application the plaintiff attacks as contrary to a treaty provision, a rule of the Patent and Trademark Office (PTO). The provision and rule relate to "unity of invention," and the practical effect of the PTO's ruling on the plaintiff's application is that the plaintiff will have to file two applications instead of one. The treaty provisions involved are in the Patent Cooperation Treaty (PCT). The matter is before the court on cross motions for summary judgment, both parties agreeing that it is appropriate to resolve the issue presented by such motions.

Rule 13 of the PTO provides, in part:

Rule 13 Unity of Invention

13.1 Requirement

The international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ("requirement of unity of invention").

13.2 Claims of Different Categories

Rule 13.1 shall be construed as permitting, in particular, either of the following two possibilities:

(i) ...
(ii) in addition to an independent claim for a given process, the inclusion in the same international application of one independent claim for one apparatus or means specifically designed for carrying out the said process.

The words "specifically designed" are what give rise to the present controversy. The PTO rule, which allegedly is in conflict with the PCT rule, reads as follows:

In addition to a claim for a given process, a claim for one apparatus or means specifically designed for carrying out of the said process, that is, it cannot be used to practice another materially different process.

37 CFR 1.141(b)(2) (emphasis added).

The PTO interprets this regulation to mean:

Process and apparatus for its practice can be shown to be distinct inventions, if either or both of the following can be shown: (1) that the process as claimed can be practiced by another materially different apparatus or by hand, or (2) that the apparatus as claimed can be used to practice another and materially different process.

MPEP § 806.05(c).

If the rule and interpretation of the PTO conflicts with the PCT, it runs afoul of Article 27 of the PCT which provides in part:

(1) No national law shall require compliance with requirements relating to the form or contents of the international application different from or additional to those which are provided for in this Treaty and the Regulations.

An example, while not completely analogous, may help to illustrate the issue. If the process was the removal of a man's beard from his face, and a safety razor was the apparatus, the PTO rule and interpretation would hold that, because the razor could also be used to scrape paint from a pane of glass it was not "specifically designed" for removal of the beard. It would also hold that because the process could be performed with the use of a straight razor the safety razor was not "specifically designed" for the removal of the beard.¹

[1] The court finds the added [emphasized] portion of the PTO rule, quoted above, and its interpretation to be contrary to the PCT and thus contrary to law.²

Only a lawyer would have a problem with what appears to the court to be the plain

¹ The specific application here was much more complicated than the example. Here, the plaintiff sought to apply for an international patent for a process or method of making a toothed segment used in the drive sprocket of the final drive assembly of Caterpillar crawler tractors. The drive sprocket receives the power of the diesel engine. The toothed segments engage the chain of the track that propels the tractor. Plaintiff's application included the invention of a forging process, which included use of a three-part forging die. This process obtained the close tolerances needed on three crucial surfaces of the toothed segment so that no machining of those surfaces was required before mounting on the final drive assembly. Claims 1 to 4 of the application relate to the method of forging a sprocket segment for a track-type vehicle undercarriage; claims 5 through 9 are directed to an apparatus, including the three-part die, for forging the track-type undercarriage sprocket segment to the desired, finished dimension.

The PTO here initially ruled that the plaintiff's application did not comply with the requirements of unity of invention under the PCT because the method in claims 1 to 4 could be performed by a two-segment die, in addition to the three-segment die contemplated in the application. PTO's acting group director later found Caterpillar's protest to be unjustified, and upheld the patent examiner's findings. The acting group director also ruled that the apparatus as claimed (i.e., the three-segment die) could be used in a materially different process: a process of making a corrugated member. The Assistant Commissioner upheld the prior PTO decisions. *In re Caterpillar Tractor Co.*, 226 U.S.P.Q. (BNA) 625 (July 22, 1985), and reiterated his position on reconsideration, 228 U.S.P.Q. (BNA) 77 (November 26, 1985).

² The court adopts, as its standard of review, the "not in accordance with law" standard of the Administrative Procedure Act, 5 U.S.C. § 706(2)(A).

language of the PCT. And that plain language refutes the interpretation which the PTO gives the language and which it says is no different from that language. The PTO's position is that its interpretation is the only one which accords the word "specifically" any meaning; and that the interpretation urged by the plaintiff could be accomplished by use only of the word "designed" without the preceding adverb. Perhaps, but it does not follow that the PTO's interpretation of the word "specifically" is the correct one. The PTO's interpretation, as expressed in its opinion, is that "specifically designed" means "... that the process and apparatus can only be used with each other." *In re Caterpillar Tractor Co.*, 226 U.S.P.Q. (BNA) 625, 639 (July 22, 1985) (Dec. Comm'r. Pat.). In the court's view this is an unreasonable interpretation.

The record in this case is voluminous, but it consists mainly of what is the equivalent of the legislative history of the treaty and opinions in favor of or in opposition to one or the other interpretation of the PCT provision. As such it is not the sort of factual record which is normally binding on the court in this type of review of an agency ruling, and the court need not resort to it to determine the issue presented. Nor is the court inclined to accord substantial deference to an agency's interpretation that its own regulation is not in conflict with a treaty provision. *See Association of American Railroads v. United States*, 603 F.2d 953, 962 (D.C. Cir. 1979).

The court will therefore grant summary judgment to the plaintiff. The rejection by the PTO of the plaintiff's application is contrary to law.

ORDER

For the reasons set forth in the Memorandum Opinion this day filed, it is ORDERED and DECLARED that:

1. Summary judgment is awarded in favor of the plaintiff Caterpillar Tractor Co. against the defendant Commissioner of Patents and Trademarks.

2. The July 22, 1985 determination by the Assistant Commissioner for Patents, adhered to on reconsideration on November 26, 1985, that the invention defined by the plaintiff's method claims 1-4 and the invention defined by plaintiff's apparatus claims 5-9 lack "unity of invention," is contrary to law.

3. The action of the Commissioner of Patents and Trademarks, as represented by the said determination, on plaintiff's International Application Number PCT/US 82/01455 is reversed, and this action is remanded to the Commissioner of Patents and Trademarks for

proceedings consistent with the Memorandum Opinion, namely, to treat and process the plaintiff's application as one complying with the requirements of "unity of invention."

District Court, N. Illinois

American Hospital Supply Corporation v.
Damon Corporation

No. 83-C-7838

Decided May 27, 1986

PATENTS

1. Costs—Attorney's fees (§25.5)

Award of attorney's fees is warranted against patent infringement defendant which sought protective order that would have prevented plaintiff from conducting further discovery with respect to two patents, in view of evidence demonstrating that defendant itself informally put patents in issue in its answer to interrogatories and demonstrating that defendant thus should have known that it would be precluded from withdrawing patents from lawsuit.

Action by American Hospital Supply Corporation against Damon Corporation for patent infringement. On defendant's motion seeking reconsideration of magistrate's decision awarding plaintiff attorney's fees. Award of fees affirmed; amount awarded is reduced. See also 228 USPQ 880.

Steven Z. Szczepanski, Glen P. Belvis, and William Brinks Olds Hofer Gilson & Lione, all of Chicago, Ill., for plaintiff.

Ralph A. Loren and Lahive & Cockfield, Boston, Mass., for defendant.

Bucklo, U.S. Magistrate.

On September 10, 1985, defendant Damon Corporation ("Damon") sought a protective order from Magistrate Balog preventing plaintiff American Hospital Supply Corporation ("AHS") from conducting further discovery with respect to two patents, referred to here as the 345 and 153 patents in this patent litigation. Damon asserted that since in response to requests for admissions it had stated that it was not and would not seek royalties

from AHS under the patents, they were therefore irrelevant. AHS countered, saying that Damon had put the patents in issue by stating in answer to interrogatories and in answer to AHS's amended and supplemental complaint that AHS's Stratus analyzer fell within the claims of these patents and that it could, therefore, assert the invalidity of the patents.

Magistrate Balog denied the motion for a protective order and granted AHS's motion for attorney's fees under Rules 11 and 37, Fed. R. Civ. P. AHS submitted its order for fees in the amount of \$4,290. Damon then sought reconsideration of the fee award, which was apparently never decided. AHS, having correctly surmised that I did not realize there was a pending motion on this subject, brought this motion for decision on May 22, 1986.

[1] I have reviewed the motions, pleadings, memoranda and decisions cited by the parties and have concluded that there is no basis for reversal of Magistrate Balog's decision with respect to fees. I agree with AHS that Damon at least informally put these patents in issue when it stated in answer to AHS's interrogatory 3 that certain claims of these patents "covered" AHS's Stratus analyzer. When AHS then amended its complaint, making repeated references to these patents and alleging that the Stratus analyzer was not covered by these patents (paragraphs 77 and 78, among others), Damon denied the allegations. Certainly, at that time the patents came into issue. Thereafter, as AHS notes, decisional law that should have been known to Damon's patent attorneys clearly precluded Damon from unilaterally withdrawing the patents from this litigation. Accordingly, I see no basis for disturbing Magistrate Balog's prior decision.

I do agree with Damon that the award of fees should be reduced. AHS claims that its senior attorney, Steven Z. Szczepanski, spent 17 hours opposing Damon's motion for a protective order, that another attorney, Glen P. Belvis, spent 21 hours, and that a paralegal spent 10½ hours on the motion. A frivolous motion should not require that expenditure of time. I conclude that 15 hours is the most that can be charged to Damon, which I will divide according to my estimate of the reasonable allocation of that time to nine hours to Mr. Szczepanski, five hours to Mr. Belvis, and one hour to Ms. Schwager, the paralegal, for a total of \$1,630. Since I think Damon was justified in seeking some reduction of the amount of the fee, no award is appropriate for the motion seeking reconsideration.

District Court, D. Maryland

Unidisco, Inc. v. Schatner

No. B-80-2617

Decided August 4, 1986

PATENTS

1. Accounting — Damages — Increased or treble damages or profits (§11.35)

Jury's finding of willful infringement, together with evidence demonstrating that defendant did not obtain competent legal advice prior to initiating possibly infringing sales, and demonstrating that defendant first attempted to obtain license, warrants trebling of damages under 35 USC 284.

UNFAIR COMPETITION

2. Accounting — Damages — In general (§11.25f)

Patent and trademark owner's assertion that defendant's sale of infringing product, in owner's containers that were altered with shoddy labels, constituted unfair competition, does not set forth cause of action.

Action by Unidisco, Inc., against Robert I. Schatner for declaratory judgment of patent invalidity and non-infringement, in which defendant counterclaims against Unidisco, Inc., Veratec Corporation, and Chemed Corporation for patent infringement, unfair competition and tortious interference with contract. Judgment for defendant/counterclaimant. On parties' post-trial motions. Motions granted in part.

Francis J. Gorman and Joanne Zawitoski, both of Baltimore, Md., and Harold Haidt, New York, N.Y., for plaintiff.

Philip L. Cohan and Robert A. Sier, Jr., both of Washington, D.C., for defendants.

Black, Jr., District Judge.

ORAL OPINION OF THE COURT

THE COURT: Let me thank you all for joining me this morning in this task. In the light of the lapse of time as soon as I got to the point where I was ready to rule I thought it was worthwhile for everybody involved for me to come in and do it this way rather than take the time that might be needed to prepare a formal written opinion.

I apologize to you for the lengthy delay. It took much too long to get back to this but, in a way I don't feel solely responsible here, the nature of our operation here and our docket makes it very difficult to block out time to take care of a matter of this magnitude. I would remind everyone that we have 361 pleadings in this case. We have had 21 Post Trial Motions, which I need to rule on today. Since the judgment in this case there have been 76 pleadings filed. And when I first approached getting to work on this and got out the file the file covered my entire conference table which normally holds ten persons for conferences. So the enormity of the problem for the system where, as you all know, I have something like 600 other cases to cope with made it very difficult but, I am prepared now to rule on the pending motions by an informal oral opinion. I gather counsel have made arrangements for prompt transcription of that opinion. I do reserve the right to edit that opinion without in any way changing the result or the essential meaning but, I assure counsel that it is not contemplated that will cause any real delay today or in the next day or so.

Plaintiff, Unidisco, Inc., a Delaware corporation with its principal place of business in Michigan, filed suit against defendant Robert I. Schatner seeking a declaratory judgment of non-infringement, invalidity, and unenforceability with regard to Dr. Schatner's patent. Dr. Schatner, counterplaintiff in this litigation, counterseued Unidisco, Inc., the Veratec Corporation, a Delaware corporation with its principal place of business in Michigan, and Chemed Corporation, a Delaware corporation with its principal place of business in Ohio.

At the time relevant to this suit, Chemed was the parent corporation to Unidisco and to Veratec — the latter two are brother-sister corporations. Chemed is now independent, having been previously an 80% owned subsidiary of W.R. Grace Co. Omnicare, Inc. now owns Unidisco and Veratec, which remain brother-sister corporations.

The Court, where appropriate, will refer to the three corporations as counterdefendants. Dr. Schatner's amended counterclaims allege that Unidisco and Veratec infringed the patent, Chemed induced that infringement, the corporations unfairly competed with Dr. Schatner, and tortiously interfered with contract. After extensive discovery, this Court held an eleven week trial beginning October 1, 1984. At the request of counsel the Court bifurcated the trial as to issues of liability and damages. The jury returned an 11 question special verdict form on December 6, 1984, finding in favor of Dr. Schatner on all questions of liability. A brief damages trial was subsequently held, and the jury awarded Dr.